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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,340	02/09/2004	Yuji Harada	0171-1061P	6496

2292 7590 10/26/2004

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EXAMINER

ASHTON, ROSEMARY E

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/773,340

Applicant(s)

HARADA ET AL.

Examiner

Rosemary E. Ashton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-15 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Tesoro et al. U.S. patent no. 3,406,004.

In col. 3, line 16 Tesoro teaches the compound $\text{CH}_2=\text{CHSO}_3\text{-CH}_2\text{-(CF}_2\text{)}_9\text{-CHF}_2$ as in claim 1 of the instant applications with other compounds in claim 1 of the patent.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Caplus Abstract DN 124:87695 to Soloshonok et al.

As shown in the abstract Soloshonok teaches the compound $\text{CH}_2=\text{CHSO}_3\text{-CH}_2\text{-(CF}_2\text{)}_3\text{-CHF}_2$ as in claim 1.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Caplus Abstract DN 113:23058 to Popov et al.

As shown in the abstract Popov teaches the compound $\text{CH}_2=\text{CHSO}_3\text{-CH}_2\text{-(CF}_2\text{)}_3\text{-CHF}_2$, $\text{CH}_2=\text{CHSO}_3\text{-CH}_2\text{-(CF}_2\text{)}_5\text{-CHF}_2$ and $\text{CH}_2=\text{CHSO}_3\text{-CH}_2\text{-CF}_2\text{-CHF}_2$ as in claim 1.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Caplus Abstract DN 78:72647 to Vali et al.

As shown in the abstract Vali teaches the compound $\text{CH}_2=\text{CHSO}_3\text{-CH}_2\text{-CF}_2\text{-CF}_2\text{-CF}_3$ as in claim 1.

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6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Caplus Abstract DN 60:82680 to DE 1163797.

As shown in the abstract DE 1163797 teaches the compounds $\text{CH}_2=\text{CHSO}_3\text{-CH}_2\text{-(CF}_2\text{)}_3\text{-CHF}_2$, $\text{CH}_2=\text{CHSO}_3\text{-CH}_2\text{-(CF}_2\text{)}_5\text{-CHF}_2$ and $\text{CH}_2=\text{CHSO}_3\text{-CH}_2\text{-CF}_2\text{-CHF}_2$ as in claim 1.

Allowable Subject Matter

7. Claims 2-15 are allowed.

8. The following is an examiner's statement of reasons for allowance: No prior art was found that teaches a polymer of the monomer having formula (2) and the polymer in a photoresist composition.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosemary E. Ashton whose telephone number is 571-272-1326. The examiner works a part-time work schedule and can normally be reached M-F between 11:30 am – 5:30 pm.

If multiple attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached at 571-272-1526.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rea
October 17, 2004



Rosemary E. Ashton
Primary Examiner
Art Unit 1752

ROSEMARY ASHTON
PRIMARY EXAMINER

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